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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,271	10/23/2001	Frits Jacobus Fallaux	3833.6US	8381
24247	7590	06/06/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			NGUYEN, DAVE TRONG	
			ART UNIT	PAPER NUMBER

1632

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/038,271	<b>Applicant(s)</b> FALLAUX ET AL.	
	<b>Examiner</b> Dave T. Nguyen	<b>Art Unit</b> 1632	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,30-33 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,30-33 and 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/8/04. 2 9/2010 4</u> | 6) <input type="checkbox"/> Other: _____  |

*Handwritten signature/initials*

Claims 7-29, 34 and 39 are canceled, claims 1 and 40 are amended by the amendment dated March 7, 2005

Claims 1-6, and 30-33, and 35-38 are pending.

The examiner acknowledges the personal interview between applicant and the examiner on Feb 8, 2005. The examiner would like to thank applicants for the claim amendment and the Deposit receipt and Declaration, which facilitates the advance of the prosecution of the as-filed application.

However, during the process of checking inventors' applications, the ODP issue needs to be address before these claims can be in condition for allowance.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-6, 30-33, and 35-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of US 6033908 and of US 6306652.

Although the conflicting claims are not identical, they are not patentably distinct from each other because: The examined claims encompass a method of employing adenovirus sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers. Given that the claims of the '908 patent and the claims of the '652 patent are drawn to essentially the same concept of utilizing a system comprising a primary packaging cell consisting essentially of adenovirus sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers, the examined claims and the claims from either the patent are obvious variants of one another.

Claims 1-6, 30-33, and 35-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of US 10/125,751, claims 21, 9, and 10 of 10/219,414 and claims 1-28 of 10/618,526.

Although the conflicting claims are not identical, they are not patentably distinct from each other because: The examined claims encompass a method of employing adenovirus sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers. Given that the claims of the '751 application, or the claims of the '414 patent application and the claims of the '526

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comprising a plasmid sequence consisting essentially of adenovirus sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers, or a primary packaging cell consisting essentially of adenovirus based plasmid sequences expressing E1A and E1B but not protein IX for the making of RCA-free replication defective adenovirus carriers, the examined claims and the claims from either the patent are obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **571-272-0731**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ram Shukla*, may be reached at **571-272-0735**.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Central Fax number, which is **571-273-8300**.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

**For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.**

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Dave Nguyen  
Primary Examiner  
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**DAVE TRONG NGUYEN**  
**PRIMARY EXAMINER**